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10/612,754	07/01/2003	Thomas W. Mower	14564.37.1	5557

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EXAMINER
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SHEIKH, HUMERA.N

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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01/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/612,754

Applicant(s)

MOWER ET AL.

Examiner

Humera N. Sheikh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of the Application**

Receipt of the Request for Continued Examination (RCE), the Amendment, Applicants Arguments/Remarks and request for extension of time (3 months-granted), all filed 10/05/07 is acknowledged.

Claims 1-23 are pending in this action. Claims 1, 20 and 23 have been amended. Claims 13-19, 21 & 22 have previously been withdrawn. Claims 1-12, 20 and 23 are rejected.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/05/07 has been entered.

\* \* \* \* \*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-12, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su *et al.* (U.S. Patent Publication No. 2002/0068102 A1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755).**

The instant invention is drawn to a dietary supplement comprising: noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo.

The instant invention is also drawn to a method of improving the taste and odor of noni-based dietary supplements, comprising: providing a noni fruit product; and mixing with the noni fruit product Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including: powdered Luo Han Guo extract; and liquid Luo Han Guo extract; whereby the powdered Luo Han Guo extract provides a masking effect to cover the unpleasant

tastes and/or odors of the noni and the liquid Luo Han Guo acts as a sweetener for the dietary supplement.

The instant invention is also drawn to a method of improving the taste and odor of a noni-based dietary supplement, while simultaneously prolonging the shelf life thereof, comprising: providing a noni-based fruit product; mixing with the noni fruit product: liquid Luo Han Guo extract in an effective amount to sweeten the supplement; powdered Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including powdered Luo Han Guo; liquid Luo Han Guo; raspberry fruit concentrate; and blueberry fruit concentrate.

*Su et al.* ('102) teach a dietary supplement to reduce cellular damage within the human body, whereby the dietary supplement includes reconstituted *Morinda citrifolia* (noni) fruit juice. The dietary supplement may also include other natural juices, such as natural blueberry juice concentrate and/or another natural juice concentrate. In one implementation, where liquid is extracted from the fruit of *Morinda citrifolia* to create the dietary supplement, it is referred to as 'Tahitian Noni' (see Abstract); (page 1, ¶ 13); (pg. 3, ¶ 28).

*Su et al.* teach that when the *Morinda citrifolia* fruit is ripe or overripe, the fruit provides a foul odor and/or taste (pg. 2, ¶ 25).

To prepare the supplement, *Morinda citrifolia* juice and puree are typically blended in a homogeneous blend, after which they are mixed with other ingredients, such as flavorings, sweeteners, nutritional ingredients, botanicals, extracts, and/or colorings. For example, flavorings may include artificial and/or natural flavor or ingredients that contribute to

palatability. Sweeteners taught include natural sugars, artificial and high-intensity sweeteners. Specific sweeteners taught include natural sugars derived from corn, sucralose, stevia, saccharin, etc. (pg. 3, ¶ 35).

Consumption amounts of the dietary supplement may include more than one ounce per day or less than one ounce per day (pg. 1, ¶ 15 – pg. 2 ¶ 15).

With regard to the instant ‘method of improving taste and odor’ of noni based dietary supplements, it is the position of the Examiner that the instant method would be considered *prima facie* obvious based on the disclosure and teachings of Su *et al.*, as Su *et al.* teach a noni-based (*Morinda citrifolia*) dietary supplement that comprises at least one of flavorings and sweeteners (see for instance, Claim 13).

While Su *et al.* do not explicitly teach the instant amounts of noni fruit, the Examiner points out that, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In *re* Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is the Examiner’s position that Applicants have not demonstrated any surprising or unexpected results that accrue from the claimed amounts of noni fruit. The prior art clearly recognizes and teaches formulations based on noni fruit, particularly, *Morinda citrifolia*, used in dietary supplement formulations.

Su *et al.* as discussed above, teach that *Morinda citrifolia* provides a foul odor and/or taste when ripe or overripe. Su *et al.* also teach that flavoring agents, sweetening agents and the like are added in the supplement to contribute to palatability.

Su *et al.* do not teach inclusion of Luo Han Guo and raspberry concentrate.

**Fischer *et al.* ('965)** teach beverage and sweetening compositions comprising Luo Han Guo. The Luo Han Guo is provided in serum, puree or juice form and is used as a sweetening ingredient in place of sugar (see reference column 1, line 25 – col. 2, line 46). The use of Luo Han Guo allows for good tasting, storage-stable beverages and can be used in beverages, such as fruit juices and fruit juice-containing beverages (col. 2, lines 29-35). Luo Han Guo provides for a reduced calorie, flavoring system that has acceptable mouth feel and taste characteristics, particularly, a beverage without off-flavors (col. 2, lines 47-62); (col. 12, lines 27-30).

The Luo Han Guo-containing sweet juices can be concentrated but are mostly used as a single strength juice or as a dry powder (col. 4, lines 20-40).

Luo Han Guo is preferably present at an amount of from 0.25 to 10% (col. 10, lines 27-36). See also Examples on cols. 16-19. This amount is an overlapping amount, which reads on the instantly claimed amount of from about 0.1% to about 3%.

Flavoring agents that can be used include raspberry, blueberry and the like (col. 4, lines 4-19); (col. 11, lines 44-59). The flavoring agents are provided in amounts of from 0.01% to 3% by weight (col. 11, lines 26-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry flavorants as taught by Fischer *et al.* within the dietary supplement of Su *et al.* One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Fischer *et al.* teach a high-intensity sweetener, Luo Han Guo and teach that it is used as a sweetening agent, useful for providing good taste, with acceptable mouth feel and taste characteristics and also teach that additional flavorants and juices include raspberry to make low calorie beverages. The expected result would be an improved, palatable, reduced-calorie dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

The teachings of Su *et al.* are discussed above. Su *et al.* teach that Morinda citrifolia provides a foul odor and/or taste when ripe or overripe. Su *et al.* also teach that flavoring agents, sweetening agents and the like are added in the supplement to contribute to palatability.

Su *et al.* do not teach inclusion of Luo Han Guo and raspberry concentrate.



**Downton *et al.* ('755)** teach a sweet juice composition comprising Luo Han Guo. The sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage (see reference column 2, lines 1-26); (col. 3, lines 3-15) and Examples at cols. 12-15. An objective is to also produce a fruit juice, which is lower in sugar and calories by blending the very sweet (Luo Han Guo) juice with other fruit juices (col. 2, lines 27-30). Other suitable fruit juices disclosed include raspberry fruit juices (col. 10, lines 30-50). The sweet juice has a pH of less than about 4.5 (claim 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry juices as taught by Downton *et al.* within the dietary supplement of Su *et al.* One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Downton *et al.* teach a natural sweetener, Luo Han Guo, whereby the sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage and also teach that additional fruit juices, such as raspberry are included in the Luo Han Guo juice to make low calorie (lower sugar) beverages. The expected result would be an enhanced, palatable, low-calorie dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or

manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

With regards to the amendment to claim 1, Applicants have provided a product-by-process claim. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

\* \* \* \* \*

**Claims 1-12, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yegorova (U.S. Patent No. 6,387,370 B1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755).**

The instant invention is drawn to a dietary supplement comprising: noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo.

The instant invention is also drawn to a method of improving the taste and odor of noni-based dietary supplements, comprising: providing a noni fruit product; and mixing with the noni fruit product Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including: powdered Luo Han Guo extract; and liquid Luo Han Guo extract; whereby the powdered Luo Han Guo extract provides a masking effect to cover the unpleasant tastes and/or odors of the noni and the liquid Luo Han Guo acts as a sweetener for the dietary supplement.

The instant invention is also drawn to a method of improving the taste and odor of a noni-based dietary supplement, while simultaneously prolonging the shelf life thereof, comprising: providing a noni-based fruit product; mixing with the noni fruit product: liquid Luo Han Guo extract in an effective amount to sweeten the supplement; powdered Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including powdered Luo Han Guo; liquid Luo Han Guo; raspberry fruit concentrate; and blueberry fruit concentrate.

**Yegorova ('370)** teaches dietary supplement compositions that include extracts of *Morinda citrifolia*, also called Noni juice, and blueberry extracts (see Abstract); (col. 5, lines 22-26); (col. 6, line 66 – col. 7, line 10).

The preparations may be in solid form, such as a capsule, powder or granule, or a tablet form. Alternatively, the compositions may be dispersed into a suitable liquid. The composition may also be administered orally, preferably two to three times daily (col. 5, lines 14-20); (col. 11, lines 46-56).

The composition may comprise *Morinda citrifolia* extract in an amount ranging from about 50 mg to about 150 mg and blueberry extract in an amount ranging from about 25 mg to about 75 mg (col. 4, lines 21-34); (col. 7, lines 35-42); (col. 8, lines 62-66).

In a preferred embodiment, the compositions may comprise 100 mg of *Morinda citrifolia* extract obtained by extracting the *Morinda citrifolia* fruit with water (col. 8, lines 1-7).

According to Yegorova, compositions comprising blueberry extract have been used to retard the aging process, as blueberries comprise large amounts of antioxidants. Blueberries rank in the top five of an antioxidant assay called ORAC (oxygen radical absorbance capacity) (col. 7, lines 7-10); (col. 8, lines 31-66).

Example 1 at columns 12-13 demonstrates a composition that includes *Morinda citrifolia* (100 mg) and blueberry extract (50 mg).

While Yegorova does not explicitly teach the instantly claimed amounts of noni fruit, the Examiner points out that, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is the Examiner’s position that Applicants have not demonstrated any surprising or unexpected results that accrue from the claimed amounts of noni fruit. The prior art clearly recognizes and teaches dietary formulations based on noni fruit, particularly, *Morinda citrifolia* in combination with antioxidant-containing blueberry extract.

Yegorova does not teach inclusion of Luo Han Guo and raspberry concentrate.

**Fischer *et al.* ('965)** teach beverage and sweetening compositions comprising Luo Han Guo. The Luo Han Guo is provided in serum, puree or juice form and is used as a sweetening ingredient in place of sugar (see reference column 1, line 25 – col. 2, line 46). The use of Luo Han Guo allows for good tasting, storage-stable beverages and can be used in beverages, such as fruit juices and fruit juice-containing beverages (col. 2, lines 29-35). Luo Han Guo provides for a reduced calorie, flavoring system that has acceptable mouth feel and taste characteristics, particularly, a beverage without off-flavors (col. 2, lines 47-62); (col. 12, lines 27-30).

The Luo Han Guo-containing sweet juices can be concentrated but are mostly used as a single strength juice or as a dry powder (col. 4, lines 20-40).

Luo Han Guo is preferably present at an amount of from 0.25 to 10% (col. 10, lines 27-36). See also Examples on cols. 16-19. This amount is an overlapping amount, which reads on the instantly claimed amount of from about 0.1% to about 3%.

Flavoring agents that can be used include raspberry, blueberry and the like (col. 4, lines 4-19); (col. 11, lines 44-59). The flavoring agents are provided in amounts of from 0.01% to 3% by weight (col. 11, lines 26-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry flavorants as taught by Fischer *et al.* within the dietary supplement of Yegorova. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Fischer *et al.* teach a

high-intensity sweetener, Luo Han Guo and teach that it is used as a sweetening agent, useful for providing good taste, with acceptable mouth feel and taste characteristics and also teach that additional flavorants and juices include raspberry to make low calorie beverages. The expected result would be an improved, palatable, reduced-calorie dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

The teachings of Yegorova are delineated above.

Yegorova do not teach Luo Han Guo and raspberry concentrate.

**Downton *et al.* ('755)** teach a sweet juice composition comprising Luo Han Guo. The sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage (see reference column 2, lines 1-26); (col. 3, lines 3-15) and Examples at cols. 12-15. An objective is to also produce a fruit juice, which is lower in sugar and calories by blending the very sweet (Luo Han Guo) juice with other fruit juices (col. 2, lines 27-30). Other suitable fruit

juices disclosed include raspberry fruit juices (col. 10, lines 30-50). The sweet juice has a pH of less than about 4.5 (claim 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry juices as taught by Downton *et al.* within the dietary supplement of Yegorova. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Downton *et al.* teach a natural sweetener, Luo Han Guo, whereby the sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage and also teach that additional fruit juices, such as raspberry are included in the Luo Han Guo juice to make low calorie (lower sugar) beverages. The expected result would be an low-calorie dietary supplement composition that offers improved taste and flavoring.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

With regards to the amendment to claim 1, Applicants have provided a product-by-process claim. “[E]ven though product-by-process claims are limited by and defined by the

process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

\* \* \* \* \*

***Pertinent Art***

Prior art not relied upon but deemed relevant by Examiner:

▪ **Xiong *et al.*** (U.S. Patent No. 6,299,925 B1):

Xiong *et al.* teach a green tea extract formulation comprising Noni fruit, obtained from *Morinda citrifolia* plant. The formulation also contains fruit extracts, such as blueberry and raspberry extract (see Abstract; col. 6, lines 61-65; col. 8, Example VII; and Claim 23).

▪ **Pushpangadan *et al.*** (U.S. Patent No. 7,014,872):

Pushpangadan *et al.* teach an herbal nutraceutical formulation comprising a plant product composition of *Momordica charantia* (see claims).



*Response to Arguments*

Applicant's arguments filed 10/05/07 have been fully considered but they are not persuasive.

**35 U.S.C. §103(a) Rejections of claims 1-12, 20 and 23 over Su *et al.* (U.S. Patent Publication No. 2002/0068102 A1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755) and Yegorova (U.S. Pat. No. 6,387,370) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755):**

Applicant argued, “Neither the combination of Su and Fischer or Downton nor the combination of Yegerova and Fischer or Downton teach or address Applicant’s unexpected discovery that powered Luo Han Guo extract has a previously unknown and desirable flavor masking property that allows it to mask the unfavorable scent and/or flavor of noni juice. Sweetening is a characteristic separate and distinct from masking an unfavorable flavor and/or scent”

This argument has been considered, but was not persuasive. “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

The fact that Applicant has allegedly discovered a new property, in this case, the property being that the "powdered" extract form of Luo Han Guo provides a taste-masking and/or scent-masking effect, which would be an inherent characteristic of Luo Han Guo, does not render the claims patentable. Applicants arguments directed to the particular property (flavor/scent masking) desired by the inclusion of Luo Han Guo would be sufficiently met by the combined prior art teachings, absent any evidence or showing to the contrary.

Applicants argued, "The different characteristics of the liquid and powdered extracts of Luo Han Guo were unknown with respect to the ability to provide the liquid extract for sweetening and the powdered extract for masking the flavor and/or scent of the noni fruit."

The different characteristics, such as sweetening based on the liquid form of Luo Han Guo is explicitly disclosed by the prior art. While the flavor and/or scent masking property based on the powdered extract form of Luo Han Guo is not explicitly taught in the art, the flavor and/or scent masking property would clearly be inherent in the products of the prior art since the prior art teaches the same ingredient, Luo Han Guo; thus, the flavor and/or scent masking property would not be inseparable from the Luo Han Guo substance itself. Discovery of a new property alone is insufficient to impart patentability to the claims.

Applicant argued, "Both Fischer and Downton, alone or in combination with Su or Yegerova, teach away from the use of powdered Luo Han Guo extract. Fischer and Downton specifically state that the drying process that occurs prior to powdering causes the formation bitter, astringent and brown flavors; Fischer col. 1, lines 53-59; Downton, col. 1, lines 63-68."

This argument was not persuasive. Admittedly, the formation of bitter, astringent and brown flavors can result from the drying process as recited in the Fischer and Downton

references. However, the reference also states that the drying process preserves the fruit and removes most of the objectionable flavor from the fresh fruit. The fact that the formation of bitter, astringent and brown flavors can occur, does not deter one of ordinary skill in the art from incorporating such a drying process, which is known as an effect process, routinely used for fruits from the Momordica family.

Applicants argued, "Neither Su and Fischer or Downton nor Yeagerova and Fischer or Downton teach that a powdered extract of Luo Han Guo can be used to mask the flavor and/or scent of the noni fruit utilized in the dietary supplement or the dietary supplement itself."

This argument has been considered, but was not found persuasive. As delineated above, the fact that Applicant has allegedly discovered a new property, in this case, the property being that the "powdered" extract form of Luo Han Guo provides a taste-masking and/or scent-masking effect, was not persuasive since the properties (sweetening and taste- and/or scent-masking) would be an inherent characteristic of Luo Han Guo and therefore, the inherent property arrived at by Applicant does not impart patentability to the claimed invention. Moreover, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

With regards to the amendment to the claim language, such as of amended claim 1, Applicants have provided a product-by-process claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the

product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Absent any evidence to the contrary, the prior art would be capable of providing for both the sweetening as well as the flavor and/or scent masking properties, as desired by Applicant, based on the inclusion of Luo Han Guo in nutritional or supplemental compositions.

### ***Conclusion***

--No claims are allowed at this time.

### **Correspondence**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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HUMERA N SHEIKH  
PRIMARY EXAMINER

Art Unit 1615

December 18, 2007

*hns*